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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,927	02/06/2004	Richard Maddocks	090455-9577	7395

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EXAMINER

CEGIELNIK, URSZULA M

ART UNIT PAPER NUMBER

3712

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/773,927	MADDOCKS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Urszula M Cegielnik	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17 is/are rejected.
- 7) ☒ Claim(s) 14, 15, and 18-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/06/2004</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 3, recites "one or more transparent, spherical members". In line 6 of the same claim the phrase "each spherical member". It is not clear whether Applicant is intending to claim one or more spherical members.

Claim 9 recites "spherical members". Claim 10, which depends from claim 9, recites "spherical elements". Claim 13 recites similar inconsistent language. Furthermore, claim 9 recites a rod interconnecting the spherical members. However, claim 1, from which claim 9 depends recites the spherical member being at least one. Thus, it is not clear what applicant is intending to claim.

The above are intended as examples only. Applicant is requested to thoroughly review the claims and make any necessary corrections thereto wherever appropriate but not specifically pointed out.

***Claim Rejections - 35 USC § 103***

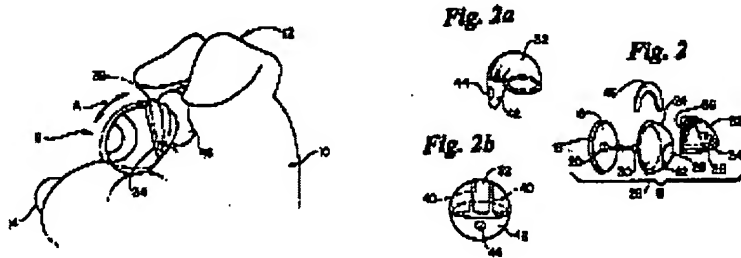
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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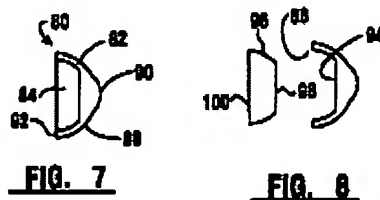
the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 8, 12, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hornsby et al. in view of Eppley.



Hornsby et al. disclose an artificial eye assembly for an animated plush toy operative to animate a portion of plush contiguous to the eye assembly comprising one or more spherical members (22) with a convex surface; at least one three-dimensional border member (32) partially surrounding and unitary with each spherical member (22), and a plush-engaging member (30) integral with each spherical member (22); a pupil and iris member (26), and a plush-animating member (40); a shaped member (42) extending from the three-dimensional eyelid member (32) and a retaining post (30).

Hornsby et al. do not disclose the spherical members having a concave surface and being transparent, and the pupil and iris inserted into the concave surface of the spherical member.



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Eppley discloses an artificial eye having a transparent spherical member (*clear thermoplastic material like polycarbonate*) having a convex outer surface (82) and a concave surface (88); a pupil (*the portion proximate reference numeral 98*) and iris (*the portion proximate reference numeral 98*) are inserted into the concave surface (88) of the spherical member (80); (col. 7, lines 46-67 through col. 8, lines 1-28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the spherical member as having a convex surface and a concave surface as taught by Eppley, since such a modification would allow an insert to be placed within the spherical member that may be hollow as suggested by Hornsby et al. (col. 4, line 27).

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the as applied to claim1 above, and further in view of Wintriss.

Hornsby et al., as modified by Eppley, lacks a rod interconnecting the spherical members; the rod is operable to effect coordinated movement of the spherical members; the rod is operable to effect independent movement of the spherical members.

Wintriss discloses an artificial eye assembly that is arranged for movement where one eye (1) or a pair of eyes (1) may move laterally along the axis of a shaft (2) or rotatably with respect to the shaft (2) (col. 1, lines 36-39).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a rod interconnecting a pair of eyes for movement of a

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single eye or a pair of eyes, since such a modification would simulate a real human or animal in terms of eye movement.

***Allowable Subject Matter***

Claim 16 is allowed.

Claims 3-7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 13, 14, and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 703-306-5806. The examiner can normally be reached on Monday through Friday, from 5:45AM - 2:15PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 703-308-1745.

**The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for both regular and After Final communications.**

Urszula M. Cegielnik  
Assistant Examiner

  
DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700